

## **REMARKS**

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

### **Regarding the Official Notice**

Paragraphs 2 and 3 of the Office Action indicates that since certain Official Notice was not traversed, that it is taken as an admission of fact. Applicants respectfully traverse that assertion and makes no admission as to the Official Notice.

MPEP 2144.03 indicates that "If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line Of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable. ... Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). ... If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (emphasis added)

In the present case, there has been no specific factual findings predicated on sound technical and scientific reasoning (or other requirements noted above) to support the Official Notice. The only support provided in the prior Office Action is a brief statement of benefits of that asserted to be well known. This clearly falls short of the requirements for establishing the required level of reasoning to support official notice. The absence of a proper assertion of

Official Notice, together with persuasive arguments that overcome the rejection, are believed to constitute a fully adequate response without inference of admissions.

Applicants acknowledge that each instance of Official Notice was not explicitly challenged in response to the prior action, however, the prior Office Action failed to establish *prima facie* obviousness, as apparently acknowledged in paragraph 1 of the present Office Action. The prior rejections were clearly fatally flawed without regard for the Official Notice, since the only reference used was for patent publication determined not to be prior art. As noted in MPEP 2142, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Applicants believe that this concept clearly extends to Official Notice – particularly in an instance where the remainder of the rejection is based upon a publication that is determined to not even constitute prior art. When a rejection is so fatally deficient, Applicant should not be required to remark about every item of evidence used in support of the rejection. Failure of a key element is adequate to defeat the *prima facie* case. Accordingly, Applicants' statement in the prior response that "Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position" should be adequate to avoid any admission in view of the failure of the Office Action to establish any viable *prima facie* rejection.

Hence, Applicants respectfully traverse the Official notice for the reason that all requirements of MPEP 2144.03 have not been properly adhered to in taking such Notice. Applicants further require proof of all assertions of Official Notice carried over into this Office Action.

It is further noted that the Official notice states that the following are well known: "that overlay windows can utilize any display characteristic desired, including any particular size, shape, or position on screen" and "to make selections between a series of items randomly". Applicants submit that even if it were admitted that these are well known, that does not constitute any admission that application of these principles to any particular invention is known or obvious in the absence of a suggestion or motivation in the art to apply these principles. Nor does such an admission imply that such knowledge is available in Applicants' field of endeavour.

### Regarding the Newly Submitted Official Notice

On page 5, second and last paragraphs; page 6, last paragraph; page 12 first paragraph; page 15 first full paragraph, the Office Action takes Official Notice regarding the use of a set top box. Applicants respectfully challenge this instance of Official Notice for the following reasons. This Official Notice fails to provide a technical line of reasoning and meet the other requirements explained above. It is further submitted that there is no basis to conclude that a set top box is necessarily smaller than a PC or necessarily has low cost. Moreover, the Office Action provides no line of reasoning as to why one of ordinary skill in the art would be motivated to seek the benefits asserted (absent hindsight).

On page 19 second paragraph and page 20, first paragraph, Applicants respectfully challenge these instances of Official Notice for the reasons discussed above.

Applicants regret the need to make the above assertive arguments, and regrets the need to burden the Examiner with presentation of proof, but has no choice when faced with multiple Official Notices and allegations of admissions.

### Regarding the Rejections under 35 U.S.C. §103

Applicants respectfully traverse the rejections as follows:

#### Regarding the Zigmond Reference

The Zigmond reference of record relates to targeted advertisements. Advertisements are inserted into content at an ad insertion device 60. Advertisements which are “appropriate” are inserted. “The selected advertisement is appropriate in the sense that it is specifically associated with characteristics of the viewer or household” (col. 4, lines 25-35). The cited passage and surrounding text indicates that Zigmond is related rather specifically to the objective of targeted advertising. Fig. 2 and the associated text suggest strongly that the type of advertisement being discussed is a conventional television commercial which interrupts the display of content for a period in order to display the commercial.

### Regarding the Butler Reference

In the Butler reference of record, hyperlink overlays are rendered on the viewer's display. In order for a user to access the underlying information identified by the hyperlink, activation of the hyperlink is required. This clearly requires a level of interactivity between the viewer and the hyperlink in order to access the content. (See, e.g., Paragraph 21).

### Arguments

The Office Action proposes the combination of Zigmond and Butler as rendering all claims obvious. The claims rejected using this combination together with Official Notice requires further evidence as requested above. Applicants respectfully traverse the rejections as follows.

#### 1. Applicants' Invention

While not wishing to be bound by this characterization, it is instructive to consider that Applicants are attempting to provide a mechanism by which multiple viewings of the same content can be made more interesting to the viewer by providing variations in ancillary information when the content is played. Generally speaking, the ancillary information is required to be related to the content and is not intended to relate to advertising. The Zigmond reference is specifically related to the targeted advertisement. Claim 1 is illustrative and is used by way of example in certain discussions below.

#### 2. The Intended Purpose is Defeated and Mode of Operation of Butler is Changed

Butler provides a system in which the user interactively and selectively accesses content by selection of a hyperlink provided. Applicants find no clear teaching of how Butler's selectively accessed content is displayed, and Applicants find no teaching of overlaying the programming content with the ancillary information – only hyperlinks, with additional information access requiring interactivity.

Applicant's claims call for overlaying first and second windows containing first and second segments of ancillary information relevant to the segment of programming, not for a

hyperlink that can be used to access ancillary information relevant to the segment of programming using some sort of interactive selection by the viewer. To modify Butler to simply display the content would substantially alter the function and mode of operation of Butler. Moreover, application of Applicants teachings in a non-interactive embodiment would defeat the function of Butler since any lack of interactivity would render the user unable to access the hyperlinked information. (Note that the claims make no requirements that a user action is required to view the ancillary information.) MPEP 2143.01 explicitly states that a modification to a reference cannot change the principle of operation of the reference; nor can the modification render the reference unsatisfactory for its intended purpose.

3. Zigmond Appears to Have No Suggestion of a Pop-Up Ad Format

Zigmond appears to select advertisements on a basis designed to present "appropriate" ads to the viewer as described above. Advertisements apparently may be replaced with other advertisements, however, it appears that the type of advertisement being discussed is a conventional television commercial which interrupts the display of content for a period in order to display the commercial. The claims call for an overlay format not suggested by Zigmond. Moreover, It is not clear how Zigmond is to be adapted to presentation of such an overlay format, other than to combine it with Butler's teachings of hyperlink overlays. In this case, the user would have to select an advertisement from a hyperlink and presumably it would be displayed as a conventional commercial interruption.

4. The Official Notice is Flawed

Certain aspects of the Official Notice are flawed as indicated above. The assertion that a set top box is "much smaller and lower cost than a personal computer" is challenged. It is submitted that 1) personal computers are and were quite small at the time of filing this application, and 2) there is no basis to assume that a set top box is or was less expensive. Due to the decryption and conditional access technology often required along with the computational requirements, the cost of a set top box can be quite high compared to a personal computer. Applicants require that proof of this assertion be presented.

5. There is No Suggestion in the Art to Combine Butler and Zigmond

The Office Action asserts that it would be obvious to modify Butler's system to include a second segment of ancillary information "for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in." Applicants submit that a mere statement of benefits of a proposed combination cannot, by itself, substitute for a teaching, suggestion or other motivation in the art for making a proposed combination. The Office Action offers col. 5, lines 1-14 and Col. 14, lines 1-9 in further support of a motivation to make the combination. These passages indicate that it is desirable to assure that advertisements are "more efficiently tailored to the needs and interests of individual viewers" in order to provide for more effective advertisements.

It is noted that the claims require (e.g., claim 1) "the selection algorithm is based upon at least one of 1) a count of a number of presentations of the segment of programming, and 2) a random selection algorithm". It is respectfully submitted that the above-cited motivation is not inherently fulfilled (and perhaps not fulfilled at all) by random selection of ancillary information or selection based upon number of presentations. In fact, it is submitted that studies show that viewers must usually see multiple presentations of an advertisement for it to be effective. This is contrary to the concept of presenting new ancillary information in the manner claimed in order to provide variety to the viewer. Thus, it is unclear how there could be a motivation to make a combination that does not provide the benefits asserted to motivate the combination.

Zigmond devotes almost the full text between col. 11, line 30 to col. 14, line 59 to the subject of refinements in the selection criterion, all within the constraints of providing "appropriate" and more efficient advertising. Applicants' ancillary information is required by the claim language to be relevant to the segment of programming. This requirement is not necessarily met by the advertisements of the embodiments of Zigmond.

Applicants note that the present invention, as claimed, was not intended to read on advertisement, but it is acknowledged that a broad interpretation of the term "ancillary information" might under certain circumstances be interpreted to include advertisements. If the

Examiner would like to have the nature of the ancillary information clarified – even so as to explicitly exclude advertisements - a suggestion as to acceptable language would be appreciated. (See interview request below.)

#### New Claim

New claim 42 is submitted for the Examiner's consideration. In this new claim, the selection algorithm also determines that during certain instances of presentation of the segment of content, the content of that segment is presented without an overlay. Note that in this claim as well as all others, the term "segment of content" is intended to embrace, for example, either a full program or a segment of a program.

It is respectfully submitted that this new claim cannot possibly be suggested by any of the cited art, since omission of an advertisement is clearly contrary to the teachings of the cited art and in fact, clearly defeats the purpose thereof. Additionally, this claim calls for no user intervention. Hence, consideration and allowance of this newly presented claim is respectfully requested. This claim finds support at the paragraph spanning pages 21 and 22.

#### Request for Interview

Applicants note that the present invention, as claimed, was not intended to embrace advertisement, per se, but it is acknowledged that a broad interpretation of "ancillary information" might under certain circumstances be interpreted to include advertisements. The undersigned would be happy to amend the claims to specifically exclude advertisement information if language can be agreed upon, or to make other suitable amendments. Accordingly, a discussion as to acceptable language or other suitable amendments would be appreciated at the Examiner's convenience.

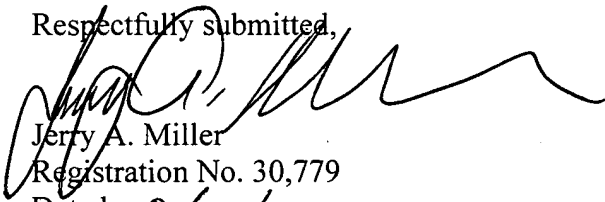
#### Concluding Remarks

The undersigned notes that many other distinctions exist between the cited art (including any Official Notice taken) and the claims. However, in view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to address each point

raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Respectfully submitted,



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